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EXAMINER

KARMIS, STEFANOS

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* ROBERT GIANNINI and
9 ROBERT J. CRAWFORD
10

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12 Appeal 2009-009186
13 Application 09/531,102
14 Technology Center 3600
15

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17 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
18 BIBHU R. MOHANTY, *Administrative Patent Judges*.
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Robert Giannini and Robert J. Crawford (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 17-31, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a way of using linked web servers for on-line shopping (Specification 1:6-7).

An understanding of the invention can be derived from a reading of exemplary claim 17, which is reproduced below [bracketed matter and some paragraphing added].

17. A system for comparison of multiple apparel articles, comprising:

[1] an on-line viewer site; and

a computer-driven web-linking engine configured and arranged to display

a first colored apparel article

selected by an on-line viewer

from the on-line viewer site for display

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed November 14, 2006) and Reply Brief ("Reply Br.," filed February 4, 2009), and the Examiner's Answer ("Ans.," mailed December 5, 2008), and Final Rejection ("Final Rej.," mailed June 23, 2006).

1 with a second colored apparel article
2 selected by an on-line viewer
3 from the online viewer site,
4 the computer-driven web-linking engine adapted
5 to use a color matching criterion
6 to determine whether the first colored apparel
7 article color matches the second colored apparel
8 article color.

9 The Examiner relies upon the following prior art:

Dial	US 5,537,211	Jul. 16, 1996
Rose	US 5,930,769	Jul. 27, 1999
Arnold	US 6,016,504	Jan. 18, 2000
Shimizu	US 6,323,969 B1	Nov. 27, 2001

10 Claims 25 and 26 stand rejected under 35 U.S.C. § 112, second
11 paragraph, as failing to particularly point out and distinctly claim the
12 invention.

13 Claims 17, 19-22, and 30-31 stand rejected under 35 U.S.C. § 103(a) as
14 unpatentable over Arnold and Dial.

15 Claim 18 stands rejected under 35 U.S.C. § 103(a) as unpatentable over
16 Arnold, Dial, and Rose.

17 Claims 23-29 stand rejected under 35 U.S.C. § 103(a) as unpatentable
18 over Arnold, Dial, and Shimizu.

ISSUES

The issue of indefiniteness turns on whether determining whether colors are compatible encompasses subjective criteria. The issues of obviousness turn on whether one would have combined a teaching of matching different wearable items with a teaching of displaying wearable items for purchase.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of “compatible.”

02. The ordinary and customary meaning of “compatible” is capable of living together harmoniously or getting along well together (with); or in agreement; congruent (with).³

Facts Related to the Prior Art

Arnold

03. Arnold is directed to a method for tracking a purchase through a "virtual outlet," (VO) where the purchase is conducted as a transaction over a network. To purchase a product, the customer requests a Web page that has a visual indication of the product and a link associated with the product.

³ Webster's New World College Dictionary (2010).
<http://www.yourdictionary.com/compatible>

1 04. Arnold's Catalog Browser routine allows one to browse
2 through catalog Web pages supplied by the merchant. Figure 10
3 shows an example catalog Web page. Items for sale are described
4 and listed along with URLs corresponding to the order Web page
5 that the merchant will supply to a customer linking through a VO
6 Web page to the merchant site in order to purchase the item. The
7 VO may incorporate items into the VO Web pages by including
8 the URLs obtained from the merchant's catalog as hot links in the
9 VO Web pages.

10 05. Arnold shows multiple colored apparel articles displayed
11 simultaneously to a user upon selection. Arnold Fig. 1B.

12 *Dial*

13 06. Dial is directed to selecting a wearable based on the color of an
14 object of interest. An input device observes the object of interest.
15 A computing device having available selections of wearables that
16 vary in color compares the object of interest with the colors of the
17 wearables in the database, and shows the match to the customer.
18 Dial 1:48-55.

19 07. Dial describes using a color comparison metric to determine
20 color matching and that Dial found the best match. Dial 6:48-61.

21 *Shimizu*

22 08. Shimizu is directed to converting color image signals between
23 color image detecting and reproducing devices such as scanners,
24 printers, displays, facsimiles and other similar devices so that an
25 image detected, displayed, or printed on one can be accurately

reproduced on another despite dissimilar color capabilities
between these devices. Shimizu 5:46-52.

09. Shimizu describes using color codes as the way for measuring
colors. Shimizu 1: Background of the Invention.

Rose

10. Rose is directed to electronic fashion shopping with a
computer. Rose 1:53-57.

11. Rose describes generating a virtual mannequin of the
customer's body showing how selected fashions will fit and look
on the customer. Rose 7:44-67.

ANALYSIS

*Claims 25 and 26 rejected under 35 U.S.C. § 112, second paragraph, as
failing to particularly point out and distinctly claim the invention.*

These claims recite automatically indicating for the on-line viewer
whether the comparison determines that the first and second colored apparel
items are color compatible. The Examiner found that there was no objective
criteria in the claim or defined in the Specification for such compatibility.

Ans. 4. The Appellants argue that the Specification provides examples of
objective ways to determine compatibility, including color charts. Appeal
Br. 6-7.

We agree with the Examiner that the scope of the claim includes
compatibility determined purely upon subjective evaluation. "The scope of
claim language cannot depend solely on the unrestrained, subjective opinion

1 of a particular individual purportedly practicing the invention” *Datamize*
2 *LLC v Plumtree Software, Inc.* 417 F.3d, 1342, 1350 (Fed. Cir. 2005).

3 The Specification does not define the meaning of compatible. FF 01.
4 The ordinary meaning is capable of living together harmoniously or getting
5 along well together with; or in agreement with. FF 02.

6 While we agree with the Appellants that the embodiments described in
7 the Specification are objective ways of determining compatibility, these are
8 exemplary only. There is no evidence the scope of the word “compatible” is
9 to be limited to these embodiments. Indeed, the Specification specifically
10 states that “[i]t should be understood [] that the intention is not to limit the
11 invention to the particular embodiments described. On the contrary, the
12 intention is to cover all modifications, equivalents, and alternatives falling
13 within the spirit and scope of the invention as defined by the appended
14 claims.”

15 Thus, the Appellants have implicitly extended the scope of the word
16 “compatible” to encompass all measures of compatibility, including those
17 determining whether it is capable of living together harmoniously or getting
18 along well together with. This clearly encompasses purely subjective
19 evaluations which one of ordinary skill would be unable to find the metes
20 and bounds of. Accordingly, we find the claims to be indefinite.

21 *Claims 17, 19-22, and 30-31 rejected under 35 U.S.C. § 103(a) as*
22 *unpatentable over Arnold and Dial.*

23 The Examiner found that Arnold described the on-line viewer site (FF
24 03) and the web-linking engine (FF 04). Arnold showed the web-linking
25 engine displaying two colored apparel articles selected by the user. FF 05.

1 The Examiner found that Dial described using color comparison to select
2 matching colors (FF 07). The Examiner found that Dial's description of
3 using best color match as the criteria for compatibility (FF 07) was evidence
4 for why one of ordinary skill would have combined the references. Ans. 5.

5 The Appellants do not contend that any limitations are missing from the
6 art, but that one would not have combined the references because Dial's
7 scanning of physical articles is incompatible with Arnold's on-line virtual
8 outlet. The Appellants also argue the references separately, whereas the
9 rejection is upon the combination of the references.

10 As to incompatibility of the references, we adopt the analysis in the first
11 paragraph found on page 12 of the Examiner's Answer, and we agree with
12 the Examiner's legal analysis that the test for obviousness is not whether the
13 secondary reference can be bodily incorporated but whether the combined
14 teachings would have suggested the claimed combination to one of ordinary
15 skill. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The Examiner
16 relied on Dial for the simple finding that it was known to match colors, not
17 for the input mechanism Dial used. The Appellants repeated their arguments
18 regarding inability to combine the references in the Reply Brief. We find
19 that as Arnold clearly describes showing multiple articles for wear and Dial
20 clearly describes the desire of customers to match colors of the items they
21 wear, it was predictable to one of ordinary skill to add some form of color
22 matching test to Arnold's display. Whether the specific input mechanism of
23 Dial is compatible with Arnold is not pertinent to this finding, as Arnold
24 already provides its own input.

25

1

2 *Claim 18 rejected under 35 U.S.C. § 103(a) as unpatentable over Arnold,*
3 *Dial, and Rose.*

4 Claim 18 displays a structure dressed with claim 17's colored apparel
5 items. The Examiner found that Rose described this (FF 11). Ans. 6-7. The
6 Appellants have not separately argued this rejection, and so the claim falls
7 with its parent claim.

8 *Claims 23-29 rejected under 35 U.S.C. § 103(a) as unpatentable over*
9 *Arnold, Dial, and Shimizu.*

10 These claims recite using color codes to compare the color of articles.
11 Although Dial's reliance on computer representations of color codes
12 necessarily means Dial uses some form of color codes, the Examiner
13 brought in Shimizu to make the teaching more explicit (FF 09). Ans. 7.

14 The Appellants argue that the matching done by Shimizu is for the
15 purpose of matching the colors reproduced by different devices rather than
16 matching codes per se. Appeal Br. 11-13. While we agree that Shimizu
17 does match the colors produced by different devices, the Examiner relied on
18 Shimizu for what is again, to make explicit what is inherent in Dial, viz. that
19 colors in data are represented by codes and so matching colors necessarily is
20 based on matching of color codes. The Examiner found that Shimizu's
21 Figure 39 showed that colors with the same code were matches, a not
22 particularly surprising finding. The Appellants' argument that this figure
23 presents data for some other purpose is unpersuasive as it is simply common
24 sense that two colors with the same code are therefore equivalent and
25 accordingly a match. The fact that Shimizu takes this equivalence and

1 considers how different devices might interpret this data differently and so
2 compensate is peripheral to the analysis of the patentability of the claims.

3 CONCLUSIONS OF LAW

4 Rejecting claims 25 and 26 under 35 U.S.C. § 112, second paragraph, as
5 failing to particularly point out and distinctly claim the invention is not in
6 error.

7 Rejecting claims 17, 19-22, and 30-31 under 35 U.S.C. § 103(a) as
8 unpatentable over Arnold and Dial is not in error.

9 Rejecting claim 18 under 35 U.S.C. § 103(a) as unpatentable over
10 Arnold, Dial, and Rose is not in error.

11 Rejecting claims 23-29 under 35 U.S.C. § 103(a) as unpatentable over
12 Arnold, Dial, and Shimizu is not in error.

13 DECISION

14 To summarize, our decision is as follows.

- 15 • The rejection of claims 25 and 26 under 35 U.S.C. § 112, second
16 paragraph, as failing to particularly point out and distinctly claim the
17 invention is sustained.
- 18 • The rejection of claims 17, 19-22, and 30-31 under 35 U.S.C. § 103(a)
19 as unpatentable over Arnold and Dial is sustained.
- 20 • The rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable
21 over Arnold, Dial, and Rose is sustained.
- 22 • The rejection of claims 23-29 under 35 U.S.C. § 103(a) as
23 unpatentable over Arnold, Dial, and Shimizu is sustained.

